



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/416,675 10/12/99 ROBINSON

E C013-1002

EXAMINER

TM02/1002

WILLIAM G LANE  
18400 VON KARMAN AVENUE  
SUITE 500  
IRVINE CA 92612

1 E 11

ART UNIT

PAPER NUMBER

2171

DATE MAILED:

10/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/416,675

Applicant(s)

Robinson

Examiner

Uyen Le

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 16, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct 12, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Answers to Amendment***

1. Claims 21-40 are now in this application. As stated by the applicant, claims 21 and 40 are similar to claims 1 and 20 except they include changes to overcome the rejection under 35 U.S.C. 112, second paragraph stated in the previous Office Action.
2. Applicant has not addressed the issue of the drawing not conforming to Rule 37 CFR 1.84 (o)) of the previous Office Action.
3. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Maniken et al (US 5,758,067) and Harari et al (US 5,887,145) do not disclose an automatic backup system wherein the backup procedure is automatically commenced by the insertion alone of the backup device into a port of the computer or host system and that in the system of Maniken, the backup does not occur until a scheduled day and time. In response, this limitation of automatically launching the backup operation by insertion alone of the backup device is not reflected in the claim language. Claims 21 and 40 merely require a computer to launch its automatic backup procedure once it recognizes that the automatic backup system (ABS) is inserted into its PCMCIA port. Claims 21 and 40 do not exclude scheduled automatic backup. Makinen explicitly shows a method of automatically backing up data from a computer (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is

Art Unit: 2171

well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include connecting a ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach peripheral cards for automatic backup of data as taught by Makinen.

For all the reasons discussed above, claims 21-40 are rejected using the references of record.

### ***Drawings***

4. The drawing is objected to because all block elements must be functionally labeled for ready identification (Rule 37 CFR 1.84 (o)). Note the single drawing representing a flow diagram submitted in this application contains labels which do not allow ready identification of its elements.

Correction is required

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makinen et al (US 5,758,067) of record, provided by the applicant, in view of Harari et al (US 5,887,145) of record.

Art Unit: 2171

Regarding claim 21, Makinen discloses a method of automatically backing up data from a computer (see the abstract). Although Makinen does not specifically show that the automatic backup system (ABS) is connected to the PCMCIA port of the computer, it is well known in the art as shown by Harari to connect peripheral cards to the PCMCIA port on a computer for backup purposes (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include connecting a ABS unit to the PCMCIA port while implementing the method taught by Makinen in order to use a standard port of the computer to attach peripheral cards for automatic backup of data as taught by Makinen. Furthermore, it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning for devices connected to the PCMCIA port, recognizing the ABS unit inserted to the PCMCIA port, launching the automatic backup procedure, scanning all source files and comparing to the files on the ABS for changes, determining space required for backing up data and space available on the ABS, making a file-by-file transfer of the changes to the ABS unit if space is available on the ABS since the computer has to recognize the presence of the ABS before launching the automatic backup and only files that have changed need be backed up again on the ABS, provided space is available on the ABS.

Regarding claim 22, official notice is taken that it is well known in the art for a computer to report the status of an operation. Therefore, it would have been obvious to one of ordinary skill in the art to make the computer report status of backup at the end

Art Unit: 2171

of the file-by-file transfer to the ABS in order to allow users to verify the status of the files being backed up.

Regarding claims 23, 24, although Makinen does not specifically show that the computer writes the status of the file-by-file transfer to the ABS unit at the end of backup to the source drives and reviews the status of the file-by-file transfer when it scans all files on the source drives and compares the files on the ABS unit for data and time changes, it would have been obvious to one of ordinary skill in the art to do so in order to keep track of which files have been last backed up at the ABS unit.

Regarding claim 25, it would have been obvious to one of ordinary skill in the art to make the computer terminate the backup after completion of writing the status of the file-by-file transfer to the ABS in order to complete the operation of backup and turn off the ABS unit.

Regarding claim 26, it would have been obvious to one of ordinary skill in the art to make the computer offer an operator a manual option to launch backup prior to the computer scanning all files on the source drive in order to allow the operator to control the operation of backup for specific files.

Regarding claim 27, it would have been obvious to one of ordinary skill in the art to make the computer automatically commence the backup procedure once the operator manually selects backup in order to automatically backing up the files selected by the operator.

Regarding claim 28, Maniken teaches an automatic backup system but fails to specifically show that the computer scans its registry for an automatic backup launch file

Art Unit: 2171

when the computer recognizes the ABS unit connected to its PCMCIA port. However, it is well known in the art as shown by Harari to connect peripherals to the PCMCIA port of a computer to backup data as discussed in claim 1. Therefore, it would have been obvious to one of ordinary skill in the art to include scanning the computer registry for an automatic backup launch file upon recognition of the presence of an ABS unit in order to automatically launch the backup operation without operator intervention.

Regarding claim 29, since a password identifies who can access data, it would have been obvious to one of ordinary skill in the art to make the computer request a password after connection of the ABS to the computer and to include all the claimed operations in order to prevent unauthorized operators to access and copy data from the computer or the ABS unit.

Regarding claim 30, since a correct password is needed for the ABS unit to operate, it would have been obvious to one of ordinary skill in the art to make the computer request a password, translate the password from its registry, transfer the password to the ABS unit connected to its PCMCIA port in order to authenticate users.

Regarding claim 31, since data should be protected from unauthorized access, it would have been obvious to one of ordinary skill in the art to include all the claimed operations while implementing the method of Maniken and Harari in order to prevent unauthorized access to data.

Regarding claim 32, it would have been obvious to one of ordinary skill in the art to include requesting the operator for a selection of options after the computer

Art Unit: 2171

recognizes the ABS unit connected to its PCMCIA port and before launching the backup procedure in order to give more flexibility to the operators who desire specific features.

Claim 33 merely reads on the fact that any application has to operate according to its configuration. Therefore, it would have been obvious to one of ordinary skill in the art to make the computer scan its registry for options selections prior to launching the backup procedure in order for the operation to perform according to the desired options set by an operator.

Regarding claim 34, since the backup system is external to the computer as shown by Hariki, it would have been obvious to one of ordinary skill in the art to make the computer request removal of the ABS unit from its PCMCIA port once the operation is completed in order to disconnect the ABS unit from the computer.

Regarding claim 35, it would have been obvious to one of ordinary skill in the art to make the computer request insertion of the ABS unit to the computer PCMCIA port in order to perform the backup operation.

Claim 36 merely reads on the fact that the computer detects the absence of the ABS unit during backup operation and requests reconnection. It would have been obvious to one of ordinary skill in the art to include the claimed operations in order to complete an ongoing backup process.

Claims 37, 38 merely read on the fact that enough space should be detected prior to launching a backup operation. Therefore, it would have been obvious to one of ordinary skill in the art to make the computer compare the space available on the ABS unit to the file changes and to replace the ABS which has insufficient space with one



Art Unit: 2171

having enough space to backup the source drives in order to avoid wasting time on an incomplete operation due to insufficient space on the ABS unit.

Regarding claim 39, since enough space is necessary to backup changed data, it would have been obvious to one of ordinary skill in the art to make the computer shut down the backup procedure when it finds there is insufficient available space to complete the backup procedure in order to avoid wasting time on an incomplete backup due to insufficient space.

Regarding claim 40, Makinen discloses an automatic backup system (see the abstract). Although Makinen does not specifically show that the system performs all the claimed operations, it is well known in the art to connect a backup system to a computer as shown by Harari (see column 3, lines 20-23, column 9, lines 18-30). Therefore, it would have been obvious to one of ordinary skill in the art to include all the claimed operations of scanning and detecting a device connected to a port of the computer, identifying the automatic backup system, automatically launching a backup procedure while implementing the system of Makinen in order to backup file changes to a system connected to the computer through a port depending on the size of the backup data as taught by Harari to avoid operator's intervention. Furthermore, since the backup system is inserted to a port of the computer, it would have been obvious to one of ordinary skill in the art to make the computer automatically close the backup procedure once the backup has been complete in order to disconnect the backup system from the computer system.

### ***Conclusion***

Art Unit: 2171

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

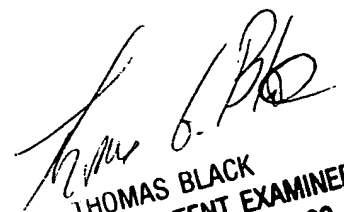
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-T 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 703-305-9707. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

UL  
October 1, 2001

  
THOMAS BLACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100